REMARKS

1. The Amendments and the Support Therefor

Fourteen claims (7, 19, 20, 24, 25, 27-33, 38, and 39) have been canceled, no new claims have been added, and claims 1, 2, 6, 8, 10, 12, 13, 16, 21, 22, 34, 36, 37, 42-47, 50, and 51 have been amended to leave claims 1-6, 8-18, 21-23, 34-37, and 42-51 in the application. Payment for any newly-submitted claims in excess of the amount previously paid for should accompany this Response, as per 37 CFR §1.16(b)-(d), with the fee due being calculated as follows:

FEE CALCULATION

For	Already Paid	No. Extra	Rate (NOT Small Entity)	Fee (NOT Small Entity)
Total Claims	34 - 48 =	0	x $52 =	$0
Independent Claims	7 - 6 =	1	x $220 =	$220
			Total:	$220

No new matter has been added by the amendments or new claims, wherein:

- Amendments are made throughout the claims to address the claim objections and §112(2) rejections of Sections 4-8 of the Office Action;
- ***Independent claim 1*** is amended to incorporate claim 7 (which was indicated as containing allowable matter), with indents / subheadings being inserted to assist in the claim's readability, and with certain limitations of clause b being moved to clause c (again to enhance readability). Because claim 1 includes allowable matter, ***claims 2-6, 10-12, 16-18, 22, 23, 34-37, 42, and 44-51***, which all ultimately depend from claim 1, should be in condition for allowance;
- ***Claim 8***, which was indicated as containing allowable matter, is amended to incorporate claim 1 (from which claim 8 depended). Because claim 8 includes allowable matter, ***claim 9***, dependent from claim 1, should be in condition for allowance;
- ***Claim 13***, which was indicated as containing allowable matter, is amended to incorporate claim 1 (from which claim 13 ultimately depended), and also intervening claim 11. Because claim 13 includes allowable matter, ***claims 14 and 15***, dependent from claim 13, should be in condition for allowance;

- ***Claim 21***, which was indicated as containing allowable matter, is amended to incorporate claim 1 (from which claim 21 ultimately depended), and also intervening claim 20;
- ***Claim 34***, dependent from claim 1 (which has been amended to incorporate the allowable matter of claim 7), should be allowable for at least the same reasons as claim 1. ***Claims 35-37***, all dependent from claim 44, should be allowable for the same reasons;
- ***Claim 44***, dependent from claim 1 (which has been amended to incorporate the allowable matter of claim 7), should be allowable for at least the same reasons as claim 1. ***Claims 45-51***, all dependent from claim 44, should be allowable for the same reasons.

Since all independent claims now incorporate matter which was indicated as allowable, all claims should be allowable. Further discussion is below.

2. Section 4 of the Office Action: Rejection of Claims 10, 27, 28, 36, and 45 under 35 USC §112(2)

These objections have been addressed by appropriate amendments to the claims.

3. Sections 5-8 of the Office Action: Rejection of Claims 6, 19, 22, 28, 30, 38, 39, and 42 under 35 USC §112(2)

These rejections have been addressed by appropriate amendments to the claims.

4. Section 9 of the Office Action: Rejection of Claims 25, 34, and 44 under 35 USC §112(2)

Kindly reconsider and withdraw these rejections. Claims 25, 34, and 44 recite methods of use of the device of claim 1. These were treated as independent claims for fee purposes, but they are otherwise proper dependent claims which meet the requirements of 35 USC §112(2) and (4). See MPEP 608.01(n):

> II. TREATMENT OF IMPROPER DEPENDENT CLAIMS
>
> . . . .
>
> 2. Note *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) for situations where a method claim is considered to be properly dependent upon a parent apparatus claim and should not be objected to or rejected under 35 U.S.C. 112, fourth paragraph.

See also MPEP § 608.01(n), "Infringement Test" for dependent claims. The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim.

III. INFRINGEMENT TEST

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. . . . .

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim since it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim.

Looking to the cited case of *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992), cited in MPEP 608.01(n), this involved a claim as follows:

> 6. A method for unloading non-packed, non-bridging and packed, bridging flowable particle catalyst and bead material from the opened end of a reactor tube which comprises utilizing the nozzle of claim 7.

At 25 USPQ2d 1147, the Board found claim 6 to be acceptable under 35 USC §112(2) and (4):

> Turning to the rejection of claim 6 under 35 USC Section 112, second and fourth paragraphs, we do not agree with the examiner that the claim is either ambiguous or non-statutory.
>
> [5] The manner in which claim 6 has been drafted has been an acceptable format for years. The format of claim 6 apparently is used more often in chemically related applications . . . . .
>
> [6] While claim 6 could be construed as an independent claim, drafted in a short-hand format to avoid rewriting the particulars of the nozzle recited in claim 7, for fee calculation purposes the Office initially treats all claims that refer to another claim as a dependent claim. M.P.E.P. Section 608.01(n), (Rev. 8, May 1988) page 600-40 under the heading, TREATMENT OF IMPROPER DEPENDENT CLAIMS. . . . .
>
> We further note that M.P.E.P. Section 608.01 (n), page 600-40, last paragraph under the heading INFRINGEMENT TEST, specifically sets forth that claims of the nature of claim 6 in this application may be proper dependent claims.
>
> Our decision herein, when considered with *Ex parte Moelands*, 3 USPQ2d 1474 (BPAI 1987) should make it clear that we do regard a claim that incorporates by reference all of the subject matter of another claim, that is, the claim is not broader in any respect,

to be in compliance with the fourth paragraph of 35 USC Section 112.

As per MPEP 608.01(n) and *Ex parte Porter*, claims 25, 34, and 44 are clear and unambiguous as per 35 USC §112(2), and also comply with 35 USC §112(4), since they simply require certain method steps to be performed with the device of claim 1. Kindly withdraw the rejections.

5. Sections 10-11 of the Office Action: Rejection of Claims 1-6, 10-12, 17-19, 22-25, 27-35, 37, and 44-51 under 35 USC §102 in view of U.S. Patent 7,303,120 to *Beenau et al.*

These claims depend from (or correspond to) independent claim 1, which has been amended to incorporate matter indicated as allowable, and thus these rejections should be overcome.

6. Sections 12-13 of the Office Action: Rejection of Claim 16 and 42 under 35 USC §103(a) in view of U.S. Patent 7,303,120 to *Beenau et al.*

These claims depend from independent claim 1, which has been amended to incorporate matter indicated as allowable, and thus these rejections should be overcome.

7. Section 14 of the Office Action: Rejection of Claim 20 under 35 USC §103(a) in view of U.S. Patent 7,303,120 to *Beenau et al.* and U.S. Patent 7,155,199 to *Zalewski*

Claim 20 is canceled, thereby mooting this rejection.

8. Section 15 of the Office Action: Rejection of Claims 38 and 39 under 35 USC §103(a) in view of U.S. Patent 7,303,120 to *Beenau et al.*, U.S. Patent 7,155,199 to *Zalewski*, and U.S. Patent 6,745,944 to *Dell*

Claims 38 and 39 are canceled, thereby mooting these rejections.

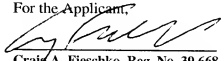
9. Sections 16-17 of the Office Action: Allowance of Claims 7-9, 13-15, 21, 36, and 43

The indication that these claims contain allowable matter is noted and appreciated. In reliance on this indication, certain of these claims have been amended into independent form.

10. In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



Craig A. Fieschko, Reg. No. 39,668
CUSTOMER NO. 25005
DEWITT ROSS & STEVENS S.C.
2 E. Mifflin St., Suite 600
Madison, WI 53703-2865
Telephone: (608) 395-6722
Facsimile: (608) 252-9243
cf@dewittross.com